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OFFICE OF PETITIONS

In re Application of :
Kinya Hasegawa, et al. :
Application No. 10/721,076 : DECISION ON PETITION
Filed: November 26, 2003 : UNDER 37 CFR 1.78(a)(3)
Attorney Docket No. 20402-00639-US :

This is a decision on the petition under 37 CFR 1.78(a)(3), filed February 11, 2005, to accept an unintentionally delayed claim under 35 U.S.C. §120 for the benefit of the prior-filed nonprovisional application set forth in the concurrently filed amendment.

The petition is **DISMISSED**.

A petition for acceptance of a claim for late priority under 37 CFR 1.78(a)(3) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate only after the expiration of the period specified in 37 CFR 1.78(a)(2)(ii). In addition, the petition under 37 CFR 1.78(a)(3) must be accompanied by:

- (1) the reference required by 35 U.S.C. § 120 and 37 CFR 1.78(a)(2)(i) of the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2)(ii) and the date the claim was filed was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional.

The petition does not comply with item (1)

37 CFR 1.78(a)(2)(i) requires that any nonprovisional application claiming the benefit of one or more prior-filed copending nonprovisional applications must contain or be amended to contain a reference to each such prior-filed application, identifying it by application number (consisting of the series code and serial number) and indicating the relationship of the applications. The relationship between the applications is whether the subject application is a continuation, divisional, or continuation-in-part of a prior-filed nonprovisional application. An example of a proper benefit claim is: "This application is a continuation of Application No. 10/---, filed---." A benefit claim that merely states: "This application claims the benefit of Application No. 10/---, filed---," does not comply with 37 CFR 1.72(a)(2)(i) since the proper relationship, which includes the type of continuing application, is not stated. Also, the status

of each nonprovisional parent application (if it is patented or abandoned) should also be indicated, following the filing date of the parent nonprovisional application. See MPEP Section 201.11, Rev. 2, May 2004, Reference to Prior Application. The amendment filed February 11, 2005 fails to state the relationship of Application No. 10/721,076, filed February 11, 2005, to this application.

Furthermore, the amendment was filed after payment of the issue fee, which was tendered August 9, 2004. Effective May 29, 2000, 37 CFR 1.312(b) was abolished. As such, submission of an amendment after payment of the issue fee is no longer permitted. In view thereof, petitioner must file a petition to withdraw from issue under 37 CFR 1.313(c)(2), accompanied by a Request for Continued Examination (RCE) and requisite fees, in order for the amendment to be considered.


Further correspondence with respect to this matter should be addressed as follows:

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Any questions concerning this matter may be directed to Marianne Jenkins at (571) 272-3223.


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